



PATENT
Customer No. 22,852
Attorney Docket No. 06478.1496

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Hans-Peter HAUSER et al.) Group Art Unit: 1656
Serial No.: 10/721,997) Examiner: SCHNIZER, Holly G.
Filed: November 26, 2003)
For: MODIFIED cDNA FACTOR VIII) Confirmation No.: 3432
AND ITS DERIVATIVES)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated October 18, 2005, the Examiner required
restriction under 35 U.S.C. § 121 between:

- Group I - Claims 11-29, drawn to factor VIII cDNAs, vectors, host cells, and methods of making the protein, classified in class 536 subclass 23.1.
- Group II - Claims 30 and 35, drawn to factor VIII proteins, classified in class 530, subclass 383.
- Group III - Claims 31-32, drawn to methods of treating hemophilia by gene therapy, classified in class 514, subclass 44.
- Group IV - Claims 33-34, drawn to methods of treating hemophilia by administering a factor VIII protein classified in class 514, subclass 2.

Applicants provisionally elect to prosecute Group I, claims 11-29, drawn to factor VIII cDNAs, vectors, host cells, and methods of making the protein, with traverse.

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Section 803 of the M.P.E.P. states that “[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”

(M.P.E.P. § 803, emphasis added.) Applicants respectfully submit that this policy should apply to this application in order to avoid unnecessary delay and duplicative examination.

Applicants submit that this search can be made without undue burden because a literature search for these groups would be largely coextensive. A thorough search for factor VIII cDNAs should necessarily involve a search for the factor VIII proteins encoded by such cDNAs. Furthermore, a thorough search for factor VIII cDNAs and proteins should also involve a search for hemophilia treatment methods using these compositions. Accordingly, Applicants respectfully request the restriction to be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 10, 2006

By: Amy E. Purcell
Amy E. Purcell
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